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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,481	11/10/2003	Sonya S. Johnson	112703-306	5154
29156	7590	09/11/2006		EXAMINER
BELL, BOYD & LLOYD LLC				ROBERTS, LEZAH
P. O. BOX 1135				
CHICAGO, IL 60690-1135				
			ART UNIT	PAPER NUMBER
			1614	

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/705,481	JOHNSON ET AL.
	Examiner	Art Unit
	Lezah W. Roberts	1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 June 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,4-11,14-16,18-20-21 and 24-33 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 24-26 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,4-11,14-16,18-20 and 27-33 is/are rejected.
- 7) Claim(s) 5 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                                  |                                                                             |
|--------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                             | Paper No(s)/Mail Date: _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>25 Aug 2006</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                                                  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

This Office action is in response to the Amendment filed June 23, 2006. All rejections have been withdrawn unless stated below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Claims*

#### Claim Objections – (New Rejection)

Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim recites the limitation comprising both a cooling agent and a heating agent. This limitation was set by the independent claim 1.

#### Claim Rejections - 35 USC § 103 - Obviousness

1) Claims 1, 4-11, 14-16, 18-20 and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Record et al. (US 5,372,824) in view of Sturtz (US Plant 8,645). The rejection is maintained.

Applicant amends the claims by reciting the compositions comprise a cooling agent and a heating agent. Applicant argues Record fails to disclose a heating agent.

Record and Sturtz also fail to disclose the step of adding Erospicata oil and a cooling agent to a consumable product as required, in part, by claims 32-33. Applicant also argues Record teaches away from the instant invention because it uses mint oils with a significant amounts of menthol and the menthol is removed before incorporated the mint oils into the gum. Applicant goes on to state "this teaches away from the present invention because Erospicata oil already contains a low l-menthol concentration". This argument is not persuasive.

As stated in the prior Office Action, a heating agent is used in the compositions of the reference. This heating agent is ethyl alcohol (Example 3A)<sup>1</sup>. In regards to claims 32-33, since the Erospicata oil would be incorporated in place of the distilled mint oils, it is incorporated into a consumable product, chewing gum, as is the mint oils of the reference. In regards to the references teaching away from the instant invention, on the contrary the reference seem to be teaching to the instant invention insofar as its ultimate goal is to remove the menthol from the mint oils to incorporate into the chewing gums. Therefore, it would have been obvious to use a mint oil, such as Erospicata oil, because it already has low menthol and one would not have to spend time distilling the menthol out of the oil.

2) Claims 1, 4-10, 27-31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakashima et al. (US 4,645,662) in view of Sturtz (US Plant 8,645). The rejection is maintained.

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<sup>1</sup> Bealin-Kelly et al. US 6,280,762, col. 1, lines 8-17.

Applicant argues Nakashima and Sturtz fails to disclose any heating agent as required, in part, by claims 1 and 11. Applicant also argues Record fails to disclose a heating agent. Record and Sturtz also fail to disclose the step of adding Erospicata oil and a cooling agent to a consumable product as required, in part, by claims 32-33. This argument is not persuasive.

Nakashima teaches compositions comprising menthol along with flavorings such as peppermint, spearmint, carvone and oleoresins. In one example, a combination of menthol, peppermint, carvone (a cooling agent) and pimento oleoresin (also known as capsicum oleoresin, a warming agent disclosed by Applicant). In regards to claims 32-33, since the Erospicata oil would be incorporated in place of the peppermint, it is incorporated into a consumable product, e.g., toothpaste, mouthwash, etc., as is the peppermint oil of the reference.

3) Applicant generally argues that the Patent Office has improperly applied hindsight reasoning by selectively piecing together teaching of each of the references in and attempt to recreate what the claimed invention discloses. Applicant further goes on to cite case law, *In re Fritch*, at 1783-17 and *In re Fine*, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988).

While “desirably” it is the ideal motivation for obviousness, it is not the only one. The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art,

established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the case of Record et al. in view of Sturtz, Record et al. teaches using mint oils and removing the menthol. Therefore it would have been obvious to have used a mint oil that contains little to no menthol as in the case of Erospicata oil, as supported by case law.

Claims 1, 4-11, 14-16, 18-20 and 27-33 are pending.

Claims 2-3, 12-13, 17 and 22-23 are cancelled.

Claims 21 and 24-26 are withdrawn.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

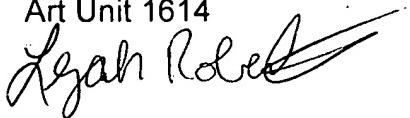
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lezah W. Roberts whose telephone number is 571-272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lezah Roberts  
Patent Examiner  
Art Unit 1614



  
Frederick Krass  
Primary Examiner  
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